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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/028,541	12/19/2001	Richard Joseph Caballero	M-12420-2C US	2447

			EXAMINER
60975	7590	05/03/2006	O'CONNOR, GERALD J

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ART UNIT	PAPER NUMBER
3627	

DATE MAILED: 05/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ___*THREE*___ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on ___*February 13, 2006*___ .

2a) ☒ This action is **FINAL**.   2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) ___*1-15 and 45-75*___ is/are pending in the application.

    4a) Of the above claim(s) ___*45-75*___ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) ___*1-15*___ is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☒ The drawing(s) filed on ___*June 18, 2002*___ is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Preliminary Remarks

1.   This Office action responds to the amendment and arguments filed by applicant on February 13, 2006 in reply to the previous Office action on the merits, mailed October 7, 2005.

2.   The amendment of claims 1, 2, 4, 6-12, 14, and 15 by applicant in the reply filed February 13, 2006 is hereby acknowledged.

Election/Restriction

3.   Applicant's traversal, in the reply filed February 13, 2006, of the restriction and consequent constructive election by original presentation of the invention defined by original claims 1-15, resulting in the non-election of new claims 45-75, is hereby acknowledged. The traversal is on the ground(s) that the various inventions are all related.

4.   Applicant's arguments have been fully considered but are not found persuasive.

5.   Regarding the argument that the inventions are not "distinct" because the inventions are "related," the Office action setting forth the requirement explained that the inventions are indeed "distinct," precisely because they are "related," and explained how and why their "relationships"

caused the related inventions to be considered "distinct." See §§ 4 and 5 of the Office action

mailed October 7, 2005.

6.   The restriction requirement is still deemed proper and is therefore made FINAL.

7.   Since applicant has already received an action on the merits for the originally presented

invention, that invention has been constructively elected by original presentation for prosecution

on the merits. Accordingly, claims 45-75 remain withdrawn from consideration as being

directed to non-elected inventions. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 101

8.   The following is a quotation of 35 U.S.C. 101:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter,
> or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and
> requirements of this title.

9.   Claims 1-15 are rejected under 35 U.S.C. 101 because the claimed invention is directed

to non-statutory subject matter. Method claims 1-15, notwithstanding their being styled as

"computer-implemented," require neither a computer, nor any other apparatus, to perform, and

are therefore drawn merely to a method of producing a disembodied data structure. It has been

held that such claims are considered to comprise non-statutory subject matter, for merely

manipulating an abstract idea without producing any "useful, concrete, and tangible result." *In

re Warmerdam*, 33 F.3d 1354; 31 USPQ2d 1754 (Fed. Cir. 1994).

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

11. Claims 1-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Wiecha et al.

(US 5,870,717).

Wiecha et al. disclose a computer-implemented method comprising: generating a list of

accounts; selecting a selected account by detecting selection of one of the accounts; generating a

list of orders associated with the selected account, wherein the list of orders comprises orders

that have been submitted for provisioning; selecting a selected order by detecting selection of

one of the orders that has been submitted for provisioning; detecting a request to make a change

to the selected order, wherein the request comprises a change to the selected order; incorporating

the change in the selected order; submitting a re-submitted order by submitting the selected order

for provisioning; and, synchronizing the re-submitted order in an external provisioning system to

override the one of the orders that had been submitted for provisioning.

Regarding claim 2, the method of Wiecha et al. further comprises: generating a list of

items comprising the selected order; determining whether each item in the list of items has been

delivered; selecting a selected item by detecting selection of one of the items; and, allowing a

user to reconfigure the selected item if the selected item has not been delivered.

Regarding claim 3, the method of Wiecha et al. further comprises: changing the status of

the selected item to indicate that the selected item has been updated.

Regarding claim 4, the method of Wiecha et al. further comprises: changing the status of

the selected order to indicate that the selected order has been updated.

Regarding claim 5, the method of Wiecha et al. further comprises: generating a list of

quotes associated with the selected account.

Regarding claim 6, the method of Wiecha et al. further comprises: generating a list of

quotes associated with the selected account; selecting a quote by detecting selection of one of the

quotes; detecting a request to make a change to the selected quote; and, incorporating the change

in the selected quote.

Regarding claim 7, the method of Wiecha et al. further comprises: generating a list of

assets associated with the selected account; selecting a selected asset by detecting selection of

one of the assets; detecting a request to make a change to the selected asset; and, incorporating the change to the asset in a quote.

Regarding claim 8, the method of Wiecha et al. further comprises: submitting the selected quote to an order.

Regarding claim 9, the method of Wiecha et al. further comprises: generating a list of items comprising the selected asset; selecting a selected item by detecting selection of one of the items; and, allowing a user to reconfigure the selected item.

Regarding claim 10, the method of Wiecha et al. further comprises: ungrouping the selected item with a quantity of more than one to a corresponding multiple of items; and, allowing the user to individually reconfigure each item of the multiple of items.

Regarding claim 11, the method of Wiecha et al. further comprises: , further comprising: generating a list of quotes associated with the selected account; selecting a selected quote by detecting selection of one of the quotes; and, detecting selection of an option to update potential revenue based on the price of items in the selected quote.

Regarding claim 12, the method of Wiecha et al. further comprises: detecting selection of an option to create a quote for a new asset, wherein the quote is associated with the selected account; generating a list assets comprising products and services available; selecting a selected asset by detecting selection of an asset; and, invoking a product configurator to allow the user to configure the selected asset.

Regarding claim 13, in the method of Wiecha et al. the change comprises disconnecting the asset.

Regarding claim 14, in the method of Wiecha et al. the change comprises transferring the selected asset, the method further comprising: detecting selection of an option to transfer the selected asset; copying information about the configuration of the selected asset to a quote; setting the status of items in the quote to indicate that the items are to be included in a service profile at a new address; and, copying information about the selected asset.

Regarding claim 15, the method of Wiecha et al. further comprises: copying the information about the configuration of the selected asset to a second quote; and, setting the status of items in the quote to indicate that the items are to be disconnected in a service profile at an old address.

Response to Arguments

12.   Applicant's arguments filed February 13, 2006 have been fully considered but they are not deemed persuasive.

13.   Regarding the argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "submission of an order for provisioning") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

14.   Regarding the argument that Wiecha fails to disclose the claimed "synchronizing," Wiecha

indeed includes "synchronizing" a changed order to override a previous version of the order

(i.e., to replace an erroneous order with a corrected one). See, for example, the "Change orders &

Cancellations" functionality in Figure 7 on the front page (to the right of the EDI Gateway 130).

To the extent that applicant is arguing that the particular names/words/terms used by

applicant differ from the particular names/words/terms in the reference, it is well settled that the

disclosure in a reference must show the claimed elements arranged in the same manner as in the

claims, but need not be in the identical words as used in the claims in order to be anticipatory. See

In re Bond, 15 USPQ2d 1566 (Fed. Cir. 1990).

Conclusion

15.   The prior art made of record and not relied upon is considered pertinent to the disclosure.

16.   Applicant's amendment necessitated any new ground(s) of rejection presented in this

Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS

from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of

the mailing date of this final action and the advisory action is not mailed until after the end of the

THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the

date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be

calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

17. Any inquiry concerning this communication, or earlier communications, should be directed to the examiner, **Jerry O'Connor**, whose telephone number is **(571) 272-6787**, and whose facsimile number is (571) 273-6787.

The examiner can normally be reached weekdays from 9:30 to 6:00.

If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Mr. Alexander Kalinowski, can be reached at (571) 272-6771.

Official replies to this Office action may be submitted by any *one* of fax, mail, or hand delivery. **Faxed replies are preferred and should be directed to (571) 273-8300**. Mailed replies should be addressed to "Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450." Hand delivered replies should be delivered to the "Customer Service Window, Randolph Building, 401 Dulany Street, Alexandria, VA 22314."

GJOC
April 28, 2006

Gerald J. O'Connor
Primary Examiner
Group Art Unit 3627